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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,981	06/14/2001	Robert C. Covington JR.	11421/5	5066

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EXAMINER

FILIPCZYK, MARCIN R

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/879,981

Applicant(s)

COVINGTON ET AL.

Examiner

Marc R Filipczyk

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 15-21 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 7.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

This Action is responsive to Applicant's response filed on March 4, 2004 (paper # 4).

The original claim 1 has been canceled and new submitted claims 2-21 are presented for examination.

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 2-14 are drawn to searching system, classified in class 707, subclass 3.
  - II. Claims 15-21 are drawn to a database structure network, classified in class 707, subclass 103X.
2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

In the instant case invention I (searching system) has separate utility such as searching databases. Invention II (database structure network) has separate utility such as in any database network.
3. Because these inventions are distinct and search Groups I and II are not required to be simultaneous, restriction for examination purposes as indicated is proper.

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4. Examiner has conducted a telephone interview with David R. Schaffer on March 19, 2004 wherein the Applicants elected Group I, claims 2-14 with traverse.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126.

To expedite the process of examination Examiner interprets the second instance of claim 2 hereinafter as claim "22".

Misnumbered claim 2 (second instance) must be renumbered or the claim canceled.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-6 and "22" are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the invention is within the technological arts.

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For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited method must somehow apply, involve, use, or advance the technological arts.

In the present case, independent claim 2 only recites an abstract idea. The recited steps of merely receiving, associating and forwarding data do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to identify and forward data.

Since the claimed invention, as a whole, is not within the technological arts as explained above, claim 2, claims 3-6 and “22” which depend from claim 2, are deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-14 and “22” are rejected under 35 U.S.C. 103(a) as being unpatentable over by Weil et al (US 2003/0093409) in view of Foulger et al (U.S. Patent No. 6,578,022).

Regarding claims 2 and 7-11, Weil discloses a method, system and network for providing a user-specific response, the system comprising (fig. 1, items 104, 120 and 130 Weil):

receiving an inquiry from a user; (fig. 2, items 136 and 210, Weil)

associating the user with a search profile designated by a subscriber; (fig. 2, 214, Weil)

conducting a search delimited by the search profile; (fig. 2, 220, Weil)

providing a search result to the user; (fig. 2, 240, Weil)

reporting the search result to the subscriber; (fig. 2, 250, Weil) and,

receiving a request for additional information from the user; (page 4, par. 27, lines 1-5, Weil), but Weil does not teach an expert system.

However, Foulger teaches an interactive intelligent searching system (title, Foulger) wherein an expert is in contact with a user in response to a user's request (fig. 1, items 110, 125 and 135, Foulger). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used an expert in Weil as used in Foulger by interconnecting the expert to the internet network of Weil (fig. 1, 120, Weil). One would have been motivated to use an expert in the Weil system to provide answers to customer requests not contained in the content files and databases.

Regarding claim 2 (second instance) herein "22", Weil/Foulger disclose the inquiry is in natural language form (fig. 1, 104, 108, 110, 114, Weil).

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Regarding claim 3, Weil/Foulger disclose indexing the inquiry to pre-defined search terms (page 4, par. 34, lines 1-10, Weil).

Regarding claim 4, Weil/Foulger disclose the inquiry is made by selecting at least one topic from a plurality of pre-defined topics (fig. 1, 120, Foulger).

Regarding claim 5, Weil/Foulger disclose the search profile is pre-defined by the subscriber (fig. 2, 214, Weil).

Regarding claim 6, Weil/Foulger disclose that conducting a search comprises accessing at least one database (fig. 1, 150 and associated text, Weil).

Regarding claims 12 and 13, Weil/Foulger disclose updating a database to include the consultant's response (fig. 1, 115, Foulger).

Regarding claim 14, Weil/Foulger disclose the network subscriber designates the consultant (fig. 1, 125 and 135).

### ***Response to Arguments***

Applicant's arguments filed on March 4, 2004 have been fully considered but they are not persuasive. The arguments and responses are listed below.

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Applicant argues on pages 7-9 of the 3/4/2004 response that the newly submitted claims 2-21 are not anticipated by Weil et al.

In response to Applicant's arguments, Examiner agrees. As such, a new ground rejection is presented.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R Filipczyk whose telephone number is 703-305-7156. The examiner can normally be reached on Mon-Fri, 8am-4:30pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF

March 19, 2004



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